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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,607	06/24/2003	Gregory S. Hamilton	054707-1225	8963
29728	7590	03/07/2005	EXAMINER	
GUILFORD PHARMACEUTICALS C/O			CHANG, CELIA C	
FOLEY & LARDNER			ART UNIT	
3000 K STREET, NW			PAPER NUMBER	
WASHINGTON, DC 20007-5143			1625	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,607

Applicant(s)

HAMILTON ET AL.

Examiner

Celia Chang

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 72-85 is/are pending in the application.
- 4a) Of the above claim(s) 78, 79 and 81-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 72-74, 76 and 80 is/are allowed.
- 6) ☐ Claim(s) 75, 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Response filed by applicants dated Dec. 7, 2004 have been entered and considered carefully. Claims 72-74, 75 in part, 76-77 and 80 are pending. Claims 78-79, 81-85 and the remaining part of claim 75 stayed withdrawn from consideration.

Applicants' attention is drawn to that the traverse on the grounds that claims are classified in the same class cannot support lack of burden thus; the restriction has been made final. The non-elected subject matter and claims have not been deleted from the pending claims. Deletion is recommended.

2. The rejection under 35 USC 112 second paragraph because the claims expressively refer to the specification while every compound of the specification can be explicitly claimed by name or by structure. There is no good reason supporting circumstance is exceptional that the reference to the specification must be allowed. Chemical compound claims are identified by its name or structure even when compound structure is complex in nature.

In the instant case, it is further evidenced that the confusion will result from ambiguous reference to the specification, for example claim 75 and 77 both claiming "compound 4" of the specification, is it compound of example 4 on page 45 or is it the compound number 4 in Table I on page 28 ? Both can be identified as compound 4 by the claims but will be completely different were name or structure for the two compound 4 being identified.

3. The provisional rejection of claims 72-74, 75 in part, 76-77, 80 under 35 USC 102(e)(f) or (g) is dropped in view of the comparisons between the filing of WO 99/14998 and the priority provisional application 60/059,905 or 60/059,963 that the claimed compounds were not disclosed in the priority documents, thus, are not entitled to the priority benefit. Therefore, the reference cannot be a 102(e) prior art.

4. Claims 72-74 and 76, 80 are allowable. Claims 75 and 77 contain allowable compounds and their compositions when the claims are limited to the elected invention and free from 112 issues and the none elected claims 78-79, 81-85 are canceled.

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Mar. 3, 2005


Celia Chang
Primary Examiner
Art Unit 1625